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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,512	02/16/2001	Avi Yaron	12808.13USI1	5365

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EXAMINER	
AN, SHAWN S	

ART UNIT	PAPER NUMBER
2613	

DATE MAILED: 05/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/785,512	YARON, AVI	
	Examiner	Art Unit	
	Shawn S. An	2613	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 December 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-72* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *20,21,51 and 53-70* is/are allowed.

6)☒ Claim(s) *1-19,22-50,52,71 and 72* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Remarks

1. Applicant's remarks filed on 12/29/04 have been fully considered but they are not persuasive.

The Applicant presents arguments of which the combination of Okada et al and Iddan et al references would not achieve a further improved device, and Okada reference teaches away from such a combination arriving at the recited invention.

Applicant also asserts that Okada includes a capsule device.

However, after careful scrutiny of the Okada et al and Iddan et al references, the Examiner must respectively disagree, and maintain the grounds of rejection for the reasons that follow.

In response to the arguments, Okada et al indeed does disclose a capsule device, but lacking a stereoscopic device in the capsule. Okada et al further discloses an imaging unit (Fig. 1, 12) composed of a columnar capsule. However, Okada et al's columnar capsule seems to cover mostly the imaging unit, whereas the Applicant's invention (capsule) covers entire stereoscopic circuitry (includes the imaging unit) for observing patients internal body parts. Therefore, the columnar capsule is considered irrelevant, because it is definitely different than the claimed swallowable capsule.

Further, Okada et al teaches contemplating a capsule sized micromachine with an observation unit alone into a patient through his/hers mouth for realizing unrestricted observation (col. 1, lines 47-49).

Furthermore, an endoscope comprising a swallowable capsule is well known in the art.

Moreover, Iddan teaches a conventional endoscope comprising a swallowable capsule (Fig. 2).

Therefore, it would have been obvious to a person of ordinary skill in the relevant art employing a stereoscopic device as taught by Okada et al et al to simply incorporate the Iddan's swallowable capsule for portability (wireless) and easily accessing an area of interest for stereoscopic imaging for realizing unrestricted observation.

Note: the patentability (especially 103 rejection) relies heavily on an idea of whether it would have been obvious to an ordinary skill in the art to derive a concept where reference A teaching plus reference B teaching is valid given the motivations to combine. Therefore, it really does not matter whether the implementation of combined ideas would actually lead into an improved device or not, as long as one of an ordinary skill in the art reasonably realizes that the combination of references would be an obvious choice, given some motivation.

Henceforth, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-19, 22-25, and 71-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada et al (5,653,677) in view of Iddan et al (5,604,531) as discussed in the last Office action as filed on 6/29/04.

4. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okada et al and Iddan et al as applied to claim 1 above, and further in view of Adelson (5,076,687) as discussed in the last Office action as filed on 6/29/04.

5. Claims 27-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada et al and Iddan et al as applied to claim 26 above, and further in view of Watannabe (5,812,187) as discussed in the last Office action as filed on 6/29/04.

6. Claims 40-50 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada et al and Iddan et al as applied to claim 1 above, and further in view of Street (6,075,555) as discussed in the last Office action as filed on 6/29/04.

Allowable Subject Matter

7. Claims 20-21, 51, and 53-70 are allowed as having incorporated the allowable subject matter as discussed in the last Office action.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Shawn S An whose telephone number is 571-272-7324.

10. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SHAWN AN
PRIMARY EXAMINER
5/20/05